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|--|-------------|----------------------|----------------------------------|-----------------------------|
| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.              | CONFIRMATION NO.            |
| 10/510,342   | 10/05/2004  | Yukihiko Taguchi     | 018842.1319                      | 8373                        |
| 24735 7590 07/16/2009<br>BAKER BOTTS LLP<br>C/O INTELLECTUAL PROPERTY DEPARTMENT<br>THE WARNER, SUITE 1300<br>1299 PENNSYLVANIA AVE, NW<br>WASHINGTON, DC 20004-2400 |             |                      | EXAMINER<br>WEINSTEIN, LEONARD J |                             |
|  |             |                      | ART UNIT<br>3746                 | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>07/16/2009  | DELIVERY MODE<br>ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptocorrespondence@bakerbotts.com  
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oneka.davis@bakerbotts.com

|                              |                                  |                                   |  |
|------------------------------|----------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/510,342    | Applicant(s)<br>TAGUCHI, YUKIHIKO |  |
|                              | Examiner<br>LEONARD J. WEINSTEIN | Art Unit<br>3746                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 5, 2009 has been entered.
2. The examiner acknowledges the amendments to claim 1.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 2-4 recite the limitation "partition wall." There is insufficient antecedent basis for this limitation in the claim. The "partition wall" of claims 2-4 corresponds to the "fixed partition wall" of claim 1 and will be considered as so for the purposes of the office action on the merits that follows.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,939,112. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims the general subject matter the variable displacement compressor claimed in claims: **[claim 1]** a discharge chamber, (Claim 1 - col. 8 ll. 45), a suction chamber (Claim 1; col. 8 ll. 44), a crank chamber, (Claim 1; col. 8 ll. 46), said compressor comprising a displacement control valve disposed at a position in a discharge pressure supply passageway capable of communicating with said crank chamber from said discharge chamber, (Claim 1; col. 8 ll. 47-48), and a fixed orifice provided at a position in a pressure relief passageway communicating with said suction chamber from said crank chamber, (Claim 1; col. 8 ll. 49-50/ 55-65), said displacement control valve being controlled in opening/closing operation to regulate a pressure in said crank chamber to control a piston stroke (Claim 1; col. 8 ll. 51-54), wherein said

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displacement control valve further comprises a pressure sensing member being expanded and contracted by sensing a pressure in said suction chamber or said crank chamber (Claim 9; col. 9 ll. 38-39; 41-45), a valve element one end of which is brought into contact with said pressure sensing member and which has a valve part opening and closing a valve hole formed in said discharge pressure supply passageway in response to an expansion/contraction of said pressure sensing member (Claim 9; col. 9 ll. 38-45), a valve chamber in which said valve part is disposed and to which a pressure in said crank chamber acts (Claim 1; col. 8 ll. 51-54 - first path of '112 analogous to valve chamber claimed), a fixed partition wall disposed around said valve element at a position in an axial direction of said valve element (Claim 1; col. 8 ll. 55-56), a pressure chamber which is partitioned from said valve chamber by said partition wall and to which a pressure in said suction chamber acts (Claim 1; col. 8 ll. 61-63 - second path of '112 analogous to pressure chamber claimed), and a solenoid provided to the other end of said valve element and capable of controlling an opening degree of said valve part by increase/decrease of an electromagnetic force, (Claim 11; col. 10 ll. 5-7) and said pressure relief passageway from said valve chamber to said pressure chamber is formed by a gap between said partition wall and said valve element for forming a non-contact structure which does not give a sliding resistance relative to a movement of said valve element in its axial direction (Claim 1; col. 8 ll. 55-65, wherein said pressure relief passageway continuously is open (Claim 1; col. 8 ll. 61-63 - annulus of '112 analogous to continuously open pressure relief passageway - claimed as annulus meaning a space not a port of an orifice therefore no implication that orifice closes); **[claim 2]** wherein

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said gap forms said fixed orifice (Claim 1; col. 8 ll. 61-63 - annulus of '112 analogous to continuously open - claimed as annulus meaning a space not a port of an orifice therefore no implication that orifice closes); **[claim 3]** wherein said partition wall is fixed at a valve casing side of said displacement control valve, and said gap is defined between an inner (Claim 1; col. 8 ll. 55-57).

***Allowable Subject Matter***

8. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD J. WEINSTEIN whose telephone number is (571)272-9961. The examiner can normally be reached on Monday - Thursday 7:00 - 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on (571) 272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leonard J Weinstein/  
Examiner, Art Unit 3746



6/29/09